

RESPONSE AND REMARKS

REJECTION UNDER SECTION 112 REJECTIONS

The Office Action rejected Claim 26 under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Office Action, "[t]he claim language is unclear 'wherein the second label is arranged on the single sheet of self-adhesive labels in a landscape orientation with respect to a portrait orientation of the single sheet of self-adhesive labels'." Office Action, Topic Nos. 4-5, p. 2.

REMARKS REGARDING THE SECTION 112 REJECTION

The rejection of Claim 26 under Section 112, second paragraph, has been carefully considered. Claim 26 has been cancelled.

REJECTION UNDER SECTION 103(a)

In the Office Action, Claims 1-7, 5, 13, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block (U.S. Patent No. 6,010,156, "Block") in view of Amato et al., (U.S. Patent Publication No. 2003/0046103, "Amato"), in further view of Miller (U.S. Patent No. 6,244,763, "Miller"). Office Action, Topic No. 7, p. 3.

In the Office Action, Claims 4, 6-7, 21-23 and 25-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block in view of Amato in further view of Johnson et al., (U.S. Patent No. 6,419,782, "Johnson"). Office Action, Topic No. 8, p. 9.

In the Office Action, Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Block in view of Amato in view of Miller and in further view of Johnson. Office Action, Topic No. 9, p. 17.

RESPONSIVE REMARKS REGARDING THE REJECTIONS UNDER SECTION 103(a)

The rejections of Claims 1-7, 13, 19-28 under Section 103(a) have been carefully considered. Claims 8-12 and 14-18 were previously cancelled; Claims 23-28 have been cancelled herewith; the remaining Claims of the present application have been

amended to more distinctly recite the claimed invention. For the reasons and authorities described further below, it is respectfully asserted that the pending amended Claims of the present application are patentable over the references of record and are in condition for allowance.

It is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest barcode labels adapted for receiving a printing consisting of a one-dimensional barcode or for printing a barcode on a separate barcode label as claimed in one way or another by the amended Claims of the present application. For example, Claim 1 recites a one-dimensional barcode label as follows:

a second label ... comprising a one-dimensional barcode label, the one-dimensional barcode label comprising a set of dimensions adapted for receiving a printing consisting of a one-dimensional barcode, the one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the set of dimensions comprising a label length and a label height, the label length at least as long as the one-dimensional barcode length and the label height at least as high as the one-dimensional barcode height

Claim 2 also recites a barcode label as follows:

a second label consisting of a barcode label, wherein the barcode label is adapted to receive printing consisting of a one-dimensional barcode the barcode label comprising a label length and a label height, the one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the label length exceeding the one-dimensional barcode length and the label height exceeding the one-dimensional barcode height ...

Claim 4 recites a barcode label as follows:

a second label arranged in a landscape orientation with respect to the sheet and with respect to the first label, the second label comprising a one-dimensional barcode label, wherein the first one-dimensional barcode label is adapted to be printed with a one-dimensional barcode in landscape orientation with respect to the sheet.

Claim 5 also recites a barcode label as follows:

a second label comprising a barcode label, wherein the barcode label is adapted to be printed with a printing consisting of a one-dimensional barcode, the barcode label being arranged on the sheet in a landscape orientation with respect to the first label, the barcode label.

The Office Action concedes that “Block does not expressly disclose a ... barcode label ...”, but cites Amato as disclosing “... a mailpiece with both the PLANET™ code label and the POSTNET code label....” Office Action, Topic No. 7, p. 8 (citing paragraphs [0009] and [0015] and FIG. 1 of Amato). The Office Action also cites Block, col. 3, lines 35-36 (“... the present invention envisions the number of labels, size of each label and intended use of each label within each field to be varied to maximize the convenience and utility to the end user.”). Office Action, Topic No. 7, p. 8. The Office Action asserts, on grounds of the above-mentioned citations, that it would have been obvious to “... print bar code labels for both the mailing identification information and delivery address information.” Office Action, Topic No. 7, p. 8.

It is not disputed that various references of record disclose printing a one-dimensional barcode. However, it is respectfully asserted that none of the references of record disclose or contemplate label sets comprising separate barcode labels or printing barcodes on separate barcode labels as claimed in one way or another by the remaining Claims of the present application.

Rather than printing barcodes on separate barcode labels, it is respectfully asserted that Amato discloses a mailpiece that bears barcodes. In particular, the Amato mailpiece in Amato's FIG. 1 is described as bearing “a destination code 125” and “a sender code 120.” Amato, paragraph [0030].

Similarly, it is respectfully asserted that although Block discloses a barcode (element 315) that is printed on an address label (element 303), Block does not disclose separately printing a barcode on a separate or distinct barcode label.

It is respectfully asserted that the complete absence in the references of record, including Block and Amato, of printing a barcode or graphic symbology on a separate barcode label of a label set as claimed in one way or another by the amended Claims of the present application is evidence that Block and Amato, even when combined, do not support an assertion of obviousness of the subject limitations.

Rather, it is respectfully asserted that the Office Action's assertion of obviousness was influenced by the Specification and Claims of the present application – it is respectfully asserted that such hindsight is not a sufficient basis on which to

assert obviousness under the law. *Cf., e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis. ... With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. 'Virtually all inventions are combinations and virtually all are combinations of old elements.'.....").

Yet further, it is respectfully asserted that amended Claims 1, 2 and 3 include additional distinguishing limitations regarding length and height of such separate barcode labels. It is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest the combination of limitations recited by amended Claims 1, 2 and 3.

Moreover, it is respectfully asserted that self-adhesive label sets comprising a separate barcode label, or separately printing a barcode on a separate barcode label of a label set as claimed in one way or another by the amended Claims would be useful over the references of record in that such a separate barcode label and the claimed postage indicia label could be applied to envelopes on which delivery and return address information had been previously printed, or to envelopes with windows through which delivery and return address information is displayed. See, e.g., FIGS. 7A-11 of the present application depicting self-adhesive label sets comprising a postage indicia label and at least one separate barcode label that are adapted for affixing separately to mail pieces on which or through which delivery address information is otherwise provided.

For the reasons given above, it is respectfully asserted that the amended Claims of the present application are patentable over the references of record and are in condition for allowance.

In rejecting Claims 1, 2, 5 and 13, the Office Action takes the position that "Miller discloses a layer of self-adhesive label that separates the second label from the third label. (Fig 3)." *E.g., Office Action*, Topic No. 7, p. 4 (regarding the rejection of Claim 1).

Applicant respectfully submits that after amendment, Claims 1, 2, 5 and 13 no longer recite expanses of a layer of self-adhesive label that separates some labels from others. Accordingly, it is respectfully submitted that the assertion that Miller discloses a layer of self-adhesive label that separates labels is no longer relevant.

As further distinguished from the references of record, it is respectfully submitted that amended Claims 4, 6, 7, 13, and 19-22 claim in one way or another limitations regarding portrait orientation of some labels and landscape orientation of others, or printing on different labels in the same label set, some information in portrait orientation and printing other information in landscape orientation.

For example, amended independent Claim 7 recites:

- directing a computer postage system to print postage indicia on a postage indicia label of a first self-adhesive label arrangement set in a portrait orientation with respect to the postage indicia label; and

- directing the computer postage system to print a one-dimensional barcode on a barcode label of the first self-adhesive label arrangement set in landscape orientation with respect to the postage indicia label.

Similarly, amended independent Claim 13 recites:

- directing a computer postage system to print postage indicia on a first label of the particular label arrangement set in a portrait orientation with respect to the first label, wherein the first label of the particular label arrangement set is adapted to receive printing consisting of postage indicia; and

- directing the computer postage system to print a graphic symbology on a second label of the particular label arrangement set in a landscape orientation with respect to the first label.

For the reasons described further below, it is respectfully asserted that none of the references of record, including Block, Amato and Miller, whether considered alone or in combination, disclose, anticipate, teach or suggest label sets comprising a combination of portrait oriented and landscape oriented labels, or printing on different labels in the same label set some information in portrait orientation and other

information in landscape orientation as claimed in one way or another by amended Claims 4, 6, 7, 13, and 19-22.

It is respectfully asserted that, for example, FIGS. 7B, 7C, 12-15, 17 and 18 depict exemplary embodiments of the above-recited limitations. In particular, the Specification explains that:

For example, in FIGS. 12 through 15, postage indicia label 14 and the return address label 150 are adapted for printing postage indicia and return address respectively in portrait orientation; one-dimensional barcode label 136 is adapted for printing in a landscape orientation, a one-dimensional barcode representing either mailing identification information, such as a PLANET™ code, or delivery address information, such as a POSTNET code.

Specification, p. 19, line 27 – p. 20, line 2.

The Office Action asserts that Johnson discloses a system of printing labels "... in both horizontal and vertical positions." See, e.g., Office Action, Topic No. 8, p. 13 (referring to Claim 21); id. at p. 14 (referring to Claim 25). The assertion regarding Johnson has been carefully considered. However, for the reasons described in more detail below, it is respectfully submitted that Johnson discloses printing bar code labels with only a uniform orientation.

In particular, Johnson discloses a system for applying a bar code label over "... at least a portion of the surface on which the pre-printed bar code is located" on an item being moved along a conveyor system. See, e.g., Johnson, col. 1, line 51 – col. 2, line 34.

In order to determine the placement on an item being moved along the conveyor system of pre-printed bar codes, Johnson discloses an arrangement of a plurality of scanners. See, e.g., Johnson, FIGS. 1 and 3. In particular, Johnson describes an embodiment comprising two linear scanners (20a and 20d in FIG. 3) for scanning bar codes in "picket fence" orientation, and three raster scanners (20b, 20c and 20e in FIG. 3) for scanning bar codes in "ladder" orientation. See, e.g., Johnson, col. 5, lines 17-35 and lines 46-52. Johnson also discloses a use of a single "omniscanner" (described as a scanner that is capable of scanning in multiple directions). Johnson, col. 5, lines 37-40.

Each of the Johnson scanners is arranged to scan a designated (horizontal for raster scanners and vertical for linear scanners) range of view of articles that are conveyed past the scanners on a conveyor belt. Johnson, col. 5, lines 6-35.

That is, Johnson discloses scanning of bar codes that may have been pre-printed on an article in either a "picket fence" orientation or a "ladder" orientation with respect to the scanner views.

Johnson also discloses printing labels. However, it is respectfully asserted, for the reasons given below, that Johnson discloses only a unitary orientation of label printing. In particular, Johnson discloses a plurality of label printing and application stations (elements 22a-22f, depicted in Johnson's FIGS. 1 and 2). Johnson, col. 5, lines 55-57. Johnson's FIG. 4 is described as showing one of the label printing and application units 22. Johnson, col. 5, lines 64-65. Johnson discloses that the labels "... have uniform dimensions, for example 1 inch wide by 3½ inches tall." Johnson, col. 6, lines 4-5. Consistent with the above-described uniformity of label size, the web 44 of blank labels shown in FIG. 4 as loaded on roll support 46 and fed to the printing and tamping unit 42 depicts a plurality of uniformly-sized labels – all mounted in a uniformly vertical orientation with respect to the web 44 and with respect to articles that would be by the label printing and application unit 22.

Johnson explains that each of the respective label printing and tamping units 22a-22f are mechanically adjusted to apply labels 36a-36f at one of three elevations above the conveyor belt 12. Johnson, col. 6, lines 4-5 and lines 26-50. Johnson explains that the vertical placement of a label in relation to the height of the article as it moves past the label printing and tamping units 22a-22f depends on the respective height of the particular label printing and tamping unit 22a-22f that is employed to print and apply the label; the horizontal placement of a label along the horizontal length of the article depends on the timing of the application by the respective label printing and tamping unit 22a-22f of the label as the article is moved on the conveyor belt past the respective label printing and tamping unit 22a-22f. See Johnson, col. 7, lines 12-21; id. at col. 8, lines 60-65.

Although Johnson discloses applying labels at different positions on an article, it is respectfully submitted that Johnson only discloses that the applied bar code labels will be vertically oriented. In particular, the uniformly-vertical orientation of the applied bar code labels is evidenced by the disclosure of Johnson in FIGS. 5 and 6 of vertically-oriented labels 36; 36A-36F. Further, the uniformly-vertical orientation of the applied bar code labels is evidenced by the disclosure of Johnson of a single verification bar code scanner 56 (depicted in FIG. 7) with a "vertical viewing range." Johnson, col. 9, lines 40-48.

In view of the above-described limitation of Johnson of only a uniform orientation of label printing, it is respectfully asserted, therefore, that Johnson does not disclose, anticipate, teach or suggest, whether considered alone or with the other references of record, the limitations recited by amended Claims 4, 6, 7, 13, and 19-22 regarding portrait orientation of some labels in a set, and landscaped orientation of other labels in the same set, or printing on different labels in the same label set, some information in portrait orientation and other information in landscape orientation.

Moreover, it is respectfully asserted that none of the references of record, whether considered alone or with the other references of record, disclose, anticipate, teach or suggest the limitations recited by Claims 4, 6-7, and 21-22 regarding portrait orientation of some labels in a set, and landscaped orientation of other labels in the same set, or printing some information in portrait orientation and other information in landscape orientation.

Accordingly, it is respectfully asserted that Claims 4, 6-7, and 21-22 are therefore patentable over the references of record and are in condition for allowance.


CONCLUSION

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is

in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

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